

## **REMARKS**

### **I. Status of the Claims**

Further to this Amendment, claims 24, 27-49, and 51-76 are currently pending. Claims 27-33, 38-48, 52-73, and 76 stand as withdrawn from consideration by the Examiner. Claims 24, 34-37, 49, 51, 74, and 75 stand rejected. Independent Claims 24, 49, 74, and 75 have been amended. Support for these amendments can be found in the specification and claims as originally filed, such as, for example, pages 22 and 25-27 of the present specification. Therefore, there is written description support for this newly presented claim.

### **II. Arguments**

The Examiner has rejected claims 24, 34-37, 49, 51, and 74-75 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,880,076 ("*Vermeer*"). Office Action at page 3.

The Examiner indicates that *Vermeer* teaches a shower gel comprising sodium coconut isethionate (5-10 wt%), sodium ether lauryl sulfate (2-5 wt%), coconutamidopropyl betaine (8-15 wt%), isopropyl palmitate (0.5-1 wt%), and water. *Id.* The Examiner asserts that although *Vermeer* fails to teach the specific amount of ester as instantly claimed, it would have been obvious to optimize the dose range of *Vermeer*'s compound by routine experimentation. *Id.* The Examiner states that the motivation to optimize the dose range comes from the reasonable expectation of success one would have in achieving "optimal hair conditioning and emulsifying or dispersment properties" in the personal product composition. *Id.* Applicants respectfully disagree for the following reasons.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the difference between the prior art and the claims at issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ at 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

**A. Transparency Limitation Not Obvious in View of *Vermeer***

Applicants submit that the presently amended independent claims reciting “the composition being transparent with turbidity being less than 100 NTU” is not obvious in view of *Vermeer*, as *Vermeer* does not in anyway disclose or suggest a composition meeting this claimed limitation. Furthermore, Applicants submit that it would not be obvious to one of ordinary skill in the art reading *Vermeer* to modify the shower gel composition of *Vermeer* to obtain a composition as instantly claimed.

First, one of ordinary skill in the art would not have had any expectation of success in removing or modifying the concentration of ethylene glycol distearate in the shower gel composition disclosed in *Vermeer* in an attempt to obtain a transparent composition with turbidity being less than 100 NTU. The shower gel as disclosed by

*Vermeer* in Example 34, which is referenced by the Examiner at page 3 of the Office Action, contains ethylene glycol distearate. *Vermeer*, column 67, lines 40-55. *Vermeer* discloses using ethylene glycol distearate as a suspending agent, as well as an opacifier and pearlescent agent. *Id.* at column 28, lines 46-52 and column 31, lines 40-45. As disclosed in the instant specification, suspending agents are used to maintain insoluble conditioning agents in suspension. Specification, pages 2-3. Therefore, one of ordinary skill in the art would not have had a reasonable expectation of success in removing or modifying the concentration of this agent in the composition of *Vermeer*, while still maintaining an even dispersion of the insoluble conditioning agents in the medium. Therefore the instantly claimed composition would not have been obvious in view of *Vermeer*.

Second, one of ordinary skill in the art would not have had any expectation of success in increasing the amount of isopropyl palmitate in a modified shower gel composition containing a reduced amount of suspending agent in an attempt to obtain a transparent composition with turbidity being less than 100 NTU. As disclosed in the instant specification, insoluble conditioning agents (such as isopropyl palmitate) are known in the art to be difficult to maintain as an even dispersion. See Specification at 2. Therefore Applicants submit that one of ordinary skill in the art would not have had a reasonable expectation of success in increasing the amount of insoluble conditioning agent in a composition, as that increase would have been expected to negatively affect the stability of the composition, or require the addition of dispersing or gelling agents to the composition. See *id.* at 3. Applicants submit that one of ordinary skill in the art would have expected that increasing the amount of isopropyl palmitate in a composition

with no, or reduced concentration of suspending agent, would have increased the instability of the resulting composition. Therefore, this modification would not have been obvious to one of ordinary skill in the art.

Finally, one of ordinary skill in the art would not have had an expectation of success in choosing a glycacarbamate and glycaurea nonionic surfactant for use in the shower gel composition of *Vermeer* in an attempt to obtain a transparent composition with turbidity being less than 100 NTU. *Vermeer* discloses over eighty-seven different glycacarbamate and glycaurea nonionic surfactants. See *Vermeer* at columns 9-13. Among those eighty-seven, there are only three glycacarbamate and glycaurea nonionic surfactants that are identified as being able to produce a formulation that is clear, namely N-dodecyl D-glucocarbamate, N-octyl/decyloxypropyl D-glucocarbamate, and N-dodecyl D-glucourea. See *id.* at columns 61, lines 1-34. Therefore in an attempt to obtain a composition within the scope of the instant claims, one of ordinary skill in the art would have to choose among the eighty-seven disclosed options of glycacarbamate and glycaurea nonionic surfactants.

Furthermore, *Vermeer* discloses the use of these three only with sodium lauryl sulfate and sodium chloride. *Id.* at column 60. *Vermeer* provides no indication that these clarity enhancing glycacarbamate and glycaurea nonionic surfactants can be combined with isopropyl palmitate, or that they would provide a transparent composition upon combination. One of ordinary skill in the art would not have had an expectation of success in choosing a glycacarbamate and glycaurea nonionic surfactant for use in the shower gel composition of *Vermeer* in order to obtain a transparent composition with

turbidity being less than 100 NTU, and therefore the instantly claimed composition would not have been obvious in view of *Vermeer*.

For at least the above reasons, Applicants therefore submit that the rejection of claims 24, 34-37, 49, 51, and 74-75 under 35 U.S.C. § 103(a) as being unpatentable over *Vermeer* is improper and should be withdrawn.

**B. No Reasonable Expectation of Success in Modifying the Ester Concentration of *Vermeer***

One of ordinary skill in the art at the time of the invention would also not have had a reasonable expectation of success in modifying the concentration of isopropyl palmitate disclosed in *Vermeer*, as one of ordinary skill would have expected the adjustment to negatively affect the stability of the shower gel.

As disclosed in the instant specification, insoluble conditioning agents (such as isopropyl palmitate) are known in the art to be difficult to maintain as an even dispersion. See Specification at 2. Therefore Applicants submit that one of ordinary skill in the art would not have had a reasonable expectation of success in increasing the amount of insoluble conditioning agent in a composition, as that increase would have been expected to negatively affect the stability of the composition, or require the addition of dispersing or gelling agents to the composition. See *id.* at 3. As the addition of dispersing or gelling agents would prevent obtaining transparent or clear compositions, *id.*, this modification would be outside the scope of the presently amended claims.

*Vermeer* discloses the use of isopropyl palmitate in a shower gel, at a concentration of 0.5% to 1%, which is outside the instantly claimed range of 1.2% to 8%. *Vermeer*, column 67. The Examiner also indicates that *Vermeer* also discloses

using an emulsifier/emollient in personal product and detergent compositions at a level of 0% to 10%, of which isopropyl palmitate is an example. *Id.* at column 30, lines 24-47. This listing also includes approximately 48 additional emulsifier/emollient compounds useful in such compositions. *Id.* Therefore, although *Vermeer* discloses a range of 0% to 10%, which encompasses the instantly claimed range, *Vermeer* only discloses isopropyl palmitate at a range outside of the instantly claimed range, and as submitted above, one of ordinary skill in the art would not have had a reasonable expectation of success in optimizing the concentration of isopropyl palmitate outside of that disclosed range.

Therefore the rejection of claims 24, 34-37, 49, 51, and 74-75 under 35 U.S.C. § 103(a) as being unpatentable over *Vermeer* is improper and should be withdrawn.

### III. Conclusion

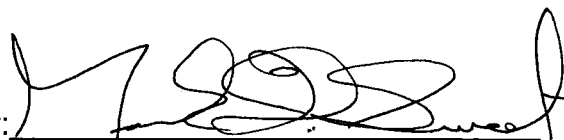
In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 2, 2009

By:



Mark D. Sweet  
Reg. No. 41,469